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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,471	08/01/2003	William James Hughes	AHUG.011	4799
7590	02/01/2005		EXAMINER	
Rudolf O. Siegesmund Suite 2000 4627 N. Central Expressway Dallas, TX 75205-4017			NICHOLSON, ERIC K	
			ART UNIT	PAPER NUMBER
			3679	

DATE MAILED: 02/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/633,471	HUGHES, WILLIAM JAMES
	<b>Examiner</b>	<b>Art Unit</b>
	Eric K Nicholson	3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 20 November 2004.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-66 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-66 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8103 122203 32404</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### **Response to Restriction**

Applicant's election with traverse filed November 20, 2004 of the restriction requirement is acknowledged. The traversal is on the grounds that Group II does indeed include the "splines and receptacles" required by the product. This has been found persuasive and an action of all the claims 1-66 appears below. The restriction requirement is withdrawn.

### **Double Patenting Rejection**

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-66 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-70 of copending Application No. 10/671,141.

### **Specification**

The disclosure is objected to because of the following informalities: On page 7 the status of the application noted therein should be updated. Appropriate correction is required.

### **Claim Rejections – 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,3,5,7,12-18,20,22,24,29-38,41-46,50-53,55,57 and 62-66 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. patent 398,620 to Jobes. The Jobes apparatus illustrates two tubing sections joined together including a plug assembly "G" having a plurality of splines "g" and a socket assembly "a" having a plurality of receptacles (page 1, lines 70-75) adapted to receive the plurality of splines. A securing device "H" for securing a plug assembly to the socket assembly wherein the plug assembly and the socket assembly can be joined in multiple orientations in relation to the number of splines. As to claims 3,20,46 and 53 the coupling collar is initially engaged with the plug assembly. As to claim 5,22 and 55 the threads can be considered course. As to claims 7,17,24,34,51 and 57 the two tubing sections are connectable in two distinct orientations. As to claims 12-14, 29-31,42-44 and 62-64 the tubing sections can be considered tubing pipe or casing. Claims 15-16, 32-33,45-46 and 65-66 are considered intended use claims and do not patently define over prior art since the tubing sections can be used in many different instances.

Claims 1,2,4,7-9,12-19,21,24-26,29-38,41-46,50-52,54,57-59 and 62-66 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. patent 6,116,658 to Bohlen. The Bohlen

apparatus illustrates two tubing sections joined together including a plug assembly 14 having a plurality of splines 46 and a socket assembly 18 having a plurality of receptacles 58 adapted to receive the plurality of splines. A securing device 30 for securing a plug assembly to the socket assembly wherein the plug assembly and the socket assembly can be joined in multiple orientations in relation to the number of splines. As to claims 2 and 19, portion 38 is considered to be the center spline with the other splines as shown in figs. 3-5 surrounding. As to claim 4,21 and 54 the threads 42 on the plug 14 can be considered fine. As to claims 7-9,17,24-26,34,51 and 57-59 the two tubing sections are connectable in two,three, four or more distinct orientations given the number of splines as shown in figs. 3-5. As to claims 12-14, 29-31,42-44 and 62-64 the tubing sections can be considered tubing pipe or casing. Claims 15-16, 32-33,45-46 and 65-66 are considered intended use claims and do not patently defined over prior art since the tubing sections can be used in many different instances.

Claims 1,3-5,7-18,20-22,24-55 and 57-66 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. patent 4,836,305 to Curlett. The Curlett apparatus illustrates two drill pipe tubing sections in figs. 2,6 and 11 joined together including a plug assembly 105 having a plurality of splines 104 and a socket assembly 103 having a plurality of receptacles 106 adapted to receive the plurality of splines. A threaded securing device 84 for securing the plug assembly to the socket assembly wherein the plug assembly and the socket assembly can be joined in multiple orientations in relation to the number of splines. As to claims 3,20,46 and 53 the coupling collar is initially engaged with the plug assembly as shown in fig. 11. As to claims 4,21 and 54 the threads can be considered fine, see columns 8-9. As to claim 5,22 and 55 the threads

can be considered course, see columns 8-9. As to claims 7-9,17,24-26,34,51 and 57-59 the two tubing sections are connectable in two distinct orientations. As to claims 10,11,27,28,39,40,60 and 61 the coupling includes a conduit 110 adapted to carry an electrical current/optical signal, see figs. 2-10 and column 10. As to claims 12-14, 29-31,42-44 and 62-64 the tubing sections can be considered tubing pipe or casing. Claims 15-16, 32-33,45-46 and 65-66 are considered intended use claims and do not patently defined over prior art since the tubing sections can be used in many different instances.

Claims 1,3-9,12-18,20-26,29-38,41-59 and 62-66 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. patent 1,781,091 to Wilson. The Wilson apparatus illustrates two drill pipe tubing sections for wells joined together including a plug assembly 1 having a plurality of splines 6 and a socket assembly 2 having a plurality of receptacles 7 adapted to receive the plurality of splines. A threaded securing device 3 for securing a plug assembly to the socket assembly wherein the plug assembly and the socket assembly can be joined in multiple orientations in relation to the number of splines. As to claims 3,20,46 and 53 the coupling collar can be initially engaged with the plug assembly 1. As to claim 4,21 and 54 the threads 4 can be considered fine. As to claim 5,22 and 55 the threads 5 can be considered course. As to claim 6,23 and 56 the threads as shown in fig. 1 are tapered. As to claims 7-9,17,24-26,34,51 and 57-59 the two tubing sections are connectable in two, three, four or more distinct orientations. As to claims 12-14, 29-31,42-44 and 62-64 the tubing sections are tubing pipe or casing, see page 1, column 1. Claims 15-16, 32-33,45-46 and 65-66 are considered intended use claims and do not patently defined over prior art since the tubing sections can be used in many different instances.

### **Claim Rejections – 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-5,7-9,12-22,24-26,29-38,41-55,57-59 and 62-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 1,589,781 to Anderson in view of U.S. patent 3,4463,228 to Hearn. The patent to Anderson discloses the claimed device with plug member 10, socket member 6 and a securing device 8 threadably holding the two together. As noted on page 1, lines 1-4 the apparatus is intended to be used for drilling tools, bits, rods or pipes, see also page 2, lines 40-45. However the coupling only includes one spline 11 on the plug member and one recess 12 on the socket member. Hearn discloses in fig. 4 that it is known in the art to provide a similar type coupling having two members 12 and 17 connected via threaded securing member 19 (see fig. 3) wherein the two coupling members include multiple splines 37 and recesses 43 to lockingly interengage the two members against rotation. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the

connection of Anderson with the multiple splines and recesses such as taught by Hearn, in order to provide a more secure coupling for the inserted tube due to increased area of interengagement between the splines and recesses and further it would have been obvious to one having ordinary skill in the art at the time the invention was made to reproduce more than one spline and recess on the Anderson coupling, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. As to claims 2 and 19, portion "a" in fig. 3 is considered to be the center spline with the other splines 11 as modified by Hearn surrounding. As to claims 3,20,46 and 53 the coupling collar 8 can be initially engaged with the plug assembly. As to claim 4,21 and 54 the threads 15 on the plug 7 can be considered fine. As to claim 5,22 and 55 the threads 14 on the socket 6 can be considered coarse. As to claims 7-9,17,24-26,34,51 and 57-59 the two tubing sections are connectable in two,three, four or more distinct orientations given the number of splines as modified by Hearn. As to claims 12-14, 29-31,42-44,47-49 and 62-64 the tubing sections can be considered tubing pipe or casing, again see page 1, lines 1-4 and page 2, line 40-45. Claims 15-16, 32-33,45-46 and 65-66 are considered intended use claims and do not patently defined over prior art since the tubing sections can be used in many different instances.

## Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

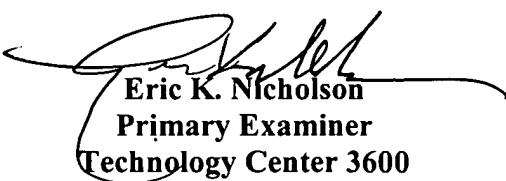
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Nicholson whose telephone number is (703) 308-0829. The examiner can normally be reached on Tuesdays thru Fridays from 7:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola, can be reached on (703) 308-2686. The fax phone number for Technology Center 3600 is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center receptionist whose telephone number is (703) 308-1113.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

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